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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/662,475 | 09/16/2003 | Katsuya Kosaki | 402784 | 9635 |
| 23548 | 7590 | 06/15/2006 | | EXAMINER |
| LEYDIG VOIT & MAYER, LTD | | | KORNAKOV, MICHAIL | |
| 700 THIRTEENTH ST. NW | | | | |
| SUITE 300 | | | ART UNIT | PAPER NUMBER |
| WASHINGTON, DC 20005-3960 | | | 1746 | |

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/662,475 | KOSAKI ET AL. | |
| | Examiner | Art Unit | |
| | Michael Kornakov | 1746 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/919,875.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>03/01/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election with traverse of claim 12 in the reply filed 04/03/2006 is acknowledged. The traversal is on the ground that claims 12 and 18 are related, the only currently pending claims in this patent application, and that examination of one of the claim will naturally result in the examination of the other of the claim. This is not found persuasive since even both claims recite a method of treating a surface of a member having a plurality of blind holes, each claim describes different processing steps to provide such treatment (producing pulsed changes in the pressure or flow rate of the treatment fluid, as per claim 12 versus reversing flow direction of the treatment fluid, as per claim 18) and therefore the search for the processing steps of claim 12 does not coexist with the search for the processing steps of claim 18. Therefore, the restriction/election of species requirement is still dimmed proper and made final.

Claim 18 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

2. Claim 12 is currently examined on the merits. In the reply dated 12/22/2005 claim 12 was amended to introduce the new limitation, reciting "**cyclically and periodically producing pulsed changes** in at least one of the pressure and the flow rate of the treatment fluid..."

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP01-128548.

JP'548 teaches treating a recess 9 (reads on the "blind hole", as instantly claimed), formed within the member 5, the recess includes an open end, a closed end and interior surfaces. The treating of recess includes circulating a solution 21 through a closed processing chamber 20 at a pressure and flow rate; contacting the opening of the recess with the solution; cyclically producing pulsed changes in pressure/flow rate of the solution 21 (Fig 2), circulating through the closed processing chamber (Fig. 1). The teaching of JP'548 does not specifically indicate treatment of a member, having a plurality of recesses. However, since mere duplication of the essential parts of a device involves only routine skill in the art, as per St. Regis Paper Co. v. Bemis Co., 193 USPQ 8., one skilled in the art would have found obvious to utilize a treatment approach of JP'548 in order to treat the member with multiple recesses with the reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Kornakov
Primary Examiner
Art Unit 1746

06/09/2006